

AMENDMENT TRANSMITTAL LETTER

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EXAMINER:

Geoffrey R. Akers

GROUP ART UNIT:

3624

INVENTION:

METHOD FOR DEVELOPING ANSWER-OPTIONS TO ISSUE-QUESTIONS RELATING TO PERSONAL FINANCE AND INVESTMENT

INVENTOR(s): Tina M. Nocera et al.

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is an amendment in the above-identified application. The fee has been calculated as shown below.

CLAIMS AS AMENDED

(1)	(2) CLAIMS REMAINING AFTER AMENDMENT	(3)	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) NO. OF EXTRA CLAIMS PRESENT	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	34	MINUS	34	0	X \$9	0.00
INDEP. CLAIMS	8	MINUS	8	0	X \$42	0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0.00

* If the entry in column 2 is less than the entry in column 4, write "0" in column 5.

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September 8, 2003

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GROUP 3600

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(Signature)

Ernest D. Buff

Attorney of Record

September 8, 2003

(Date)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**OFFICIAL**

In re Application of: Tina M. Nocera et al. Group Art Unit: 3624
Serial No.: 09/723,402 Examiner: Geoffrey R Akers
Filed: November 26, 2000
For: **METHOD FOR DEVELOPING ANSWER-OPTIONS TO
ISSUE-QUESTIONS RELATING TO PERSONAL
FINANCE AND INVESTMENT**
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Sir:

RESPONSE AFTER FINAL REJECTION UNDER 37 CFR §1.116**FAX RECEIVED****SEP 08 2003****GROUP 3600**

This is in response to the Final Rejection dated June 13, 2003. Reconsideration and withdrawal of all of the rejections are respectfully requested.

The Final Rejection repeats all of the rejections set forth in the Office Action dated March 6, 2003. The sole comment on the amendments and remarks set forth in the Amendment dated June 3, 2003 (the "prior Amendment") is the cursory statement in Paragraph 9 of the Final Rejection that "Responses are tailored to questions in the teachings of Ho."

1. Statement of Grounds of Rejection of the Claims

It is stated in Paragraph 4 of the Final Rejection that claims 1-34 are rejected under 35 USC §103 (a) as being unpatentable over Boc (USP 6,236,975) in view of Ho (USP 6,480,690). It is also

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stated in Paragraph 8 of the Final Rejection that claims 1-34 are rejected under 35 USC §112 (second paragraph) for failing to point out and distinctly claim what applicant regards is the invention.

ARGUMENTS

2. The Final Rejection is Untenable and Should be Withdrawn

It is respectfully submitted that the rejection of claims 1-34 on both grounds (35 USC §103 (a) and the 35 USC §112 (second paragraph) is in error and should be withdrawn. Reconsideration and withdrawal of all rejections is most respectfully requested.

Preliminarily, it is submitted that Applicants' arguments set forth in the prior Amendment are indeed cogent, and for the record are repeated herein in their entirety. The Examiner is respectfully directed to those comments as well as the following.

Before discussing the rejections, it is believed that a brief review of Applicants' invention would be helpful and will demonstrate the incorrectness of the rejections.

3. Description of the Invention

The present invention, as recited by claims 1 to 34, addresses and provides useful solutions to problems confronted by persons seeking to make wise decisions in the realm of personal finance and investment. It provides a multi-faceted response to questions posed regarding, e.g., investment

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strategies that are prudent for the situation of a given person based on his/her circumstances of marriage, net worth, current distribution of assets and liabilities, responsibilities for dependents, and many like factors. This response is polycentric, in that it provides numerous viewpoints (i.e., answer-options) on the topics and issues that have been posed by the issue-question.

In addition to being polycentric, the response is tailored to the issue-question presented. That is to say, the response takes into account many particular circumstances that influence wise financial planning for a given person. By considering these variables when identifying the topic groups and issue-questions, the method called for by present claims 1 to 34, as amended, provides information to a user, viewer, investment advisor, financial planner, or the like, that is specifically directed to their immediate and pressing concerns. This further restriction on or filtering of information provides a highly focused response, which is tailored to the issue-question presented.

Applicants' invention solves a very real need that is facing the average person – how to select from an increasingly diverse array of financial investment choices, as well as a need for great self-reliance in providing for one's future. Applicants have designed a method responsive to the needs of persons for assistance in finding wise and prudent approaches to financial planning. Generally stated, the method comprises the steps of (a) identifying a plurality of topics relating to personal investment and finance based upon predetermined criteria; (b) developing and recording a plurality of issue-questions directed to each of the identified personal investment and finance topics; (c) developing and recording an expert opinion for each issue-question; (d) developing and recording a prudent-investor opinion for each issue-question; (e) selecting a topic; (f) selecting an issue-question directed to the selected topic; and (g) communicating a plurality of answer-options to the selected issue-question. The plurality of answer-options comprises at least one expert opinion and one prudent-investor opinion. These are communicated to the requester in a response that is both polycentric and tailored to the issue-question.

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Advantageously, when practicing the method of the invention, the user benefits from the various views of both experts and prudent investors, and can consider the answer-options provided in addressing the specific issue that the user has identified as being important. In addition, the invention can be tailored to a specific user or audience. Through consideration of numerous variables that distinguish a given person's circumstances and present and future responsibilities, such as his/her age, marital status, dependents requiring support, occupation and present and future income prospects, and current assets and liabilities, the method of the present invention serves to (i) identify the topics most important to a specific user; (ii) prioritize these topics; and (iii) develop specific questions directed to each of the prioritized topics. Such a multi-faceted approach, which offers both professional and prudent investor advice, is neither disclosed nor suggested by the cited references.

These features are set forth in various detail in claims 1-34.

It is also pointed out for the record that the parent application has issued as U.S. Patent 6,193,518.

4. The 35 USC §112 (second paragraph) Rejection is Untenable and Should be Withdrawn

In the Final Rejection, the rejection of the first Office Action is repeated as follows:

"Claims 1-34 are further rejected under 35 USC 112 (2nd) for failing to point out and distinctly claim what applicant regards is the invention. The claims are too broad and must be narrowed to portray the distinctive character of the invention."

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It is respectfully submitted that there is nothing in the statute, rules or MPEP which supports such a rejection. Indeed, it is clear from the MPEP that the breadth of a claim is not to be equated with indefiniteness. See Section 2173.04, which is entitled "Breadth is Not Indefiniteness". The Final Rejection fails to set forth what is specifically considered to be unduly broad in any of the claims, and completely ignores the arguments that were submitted in the prior Amendment. It is certain that the Examiner had no difficulty understanding the scope of the claims as they were understood enough to posture a rejection based on 35 USC §103.

An applicant is entitled to claim the invention as the applicant sees fit, provided that the language is clear, concise and distinct. As previously pointed out, no evidence has been adduced that any of the present claims are unclear or that they recite subject matter which the Applicants did not intend to claim. Indeed, the language of the claims finds support in the specification.

It is disappointing that the Final Rejection only parrots the rejection of the first Office Action, without making any specific comments on the reasoning set forth in the prior Amendment.

As set forth in the referenced Section of the MPEP and as argued in the prior Amendment, *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971) stands for the proposition that the breadth of a claim is not to be equated with indefiniteness. Such Section goes on to state that "If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 USC 112, second paragraph".

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There are other statutory rejections that may be made if claims are somehow considered unduly broad, as suggested in the MPEP. However, the only rejection of record is that founded on the second paragraph of 35 USC §112, based on an alleged failure to point out and distinctly claim what the Applicants regard as their invention. Claims 1-34 herein must be presumed to be that regarded by Applicants as their invention, as the Patent and Trademark Office has not established anything to the contrary. It is respectfully submitted that such a rejection on the facts of this case is totally unsupportable. Therefore, withdrawal of this ground of rejection is submitted to be clearly in order and is respectfully requested.

5. The 35 USC 103 (a) Rejection Over Boe et al. in view of Ho et al. is Unwarranted

It is noted that the language of this rejection in the Final Rejection is the same as in the first Office Action, and disappointingly, the Final Rejection fails to comment at all on the amendments presented in the prior Amendment. It is respectfully submitted that claims 1-34 are indeed patentable over this proposed combination of references.

6. Boe et al. do not Disclose or Suggest the Claimed Invention

The Final Rejection alleges that Boe et al. teaches a method of providing a plurality answer-options to an issue question (citations to the Abstract and Figs. 2, 3 and 4a) and providing a computer output (citing Fig. 4b) related to financial planning (citing Fig. 4c) derived from sources including survey of data (citing col. 2, lines 13-17).

It is respectfully submitted that Boe et al. has nothing to do with the problems addressed by Applicants' invention. Rather, the reference discloses a targeted marketing system and method that provides a customer with customer questions, receives responses to the customer questions from

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the customer, and stores data associated with the responses. The customer is then provided with feedback that graphically illustrates data associated with a customer's standing in a selected peer group. The Boe et al. system is designed to collect customer data for the benefit of the operator.

Importantly, the Boe et al. system does not provide answers to questions posed by customers, let alone answers that are: (i) specifically tailored to a customer's situation and (ii) polycentric. Rather, Boe et al. system provides merely generic feedback showing how a composite of other persons with similar demographics have arranged their financial affairs. As a result, the customer is not provided with information that reflects either the advice of a knowledgeable financial expert or the experience of known prudent investors. Thus, a response from the Boe et al. system is neither tailored nor polycentric. All the Boe et al. system can do is to inform a customer of the average of the financial decisions of others similarly situated, rather than provide specific answers tailored to the questions posed and unique situation or the consumer.

7. Ho et al. do not Rectify the Shortcomings of Boe et al.

Recognizing the failure of the Boe et al. system to disclose or suggest the capability of Applicants' system to provide multifaceted, tailored answers, in the Final Rejection the Ho et al. patent is again relied upon. It was stated that Ho et al. discloses a system to teach a user based on his questions (citing the Abstract and col. 2, lines 20-36) with a rule-based methodology (citing Fig. 2/64) and an expert system database (citing Figs. 5, 6, 12 and 13).

In one embodiment, the Ho et al. system presents study materials and accepts a question from the user. The system responds with presentation of an answer to the question. The system compares the question with one or more questions previously entered by the user to determine his

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understanding of the subject and to select further study materials appropriate for the user. This is far afield from providing a response that is tailored and polycentric.

It is stated in the Final Rejection that it would be obvious to one skilled in the art to combine Boe et al. in view of Ho et al. "to teach the above", and that the motivation to combine is to disclose a system that can (answer) a user based on his questions as enunciated by Ho (col. 2, lines 14-25) and which can be applied to financial planning. It is respectfully submitted that this assertion is incorrect.

Significantly, neither Boe et al. nor Ho et al. discloses or suggests any system in which a user's question is answered with an answer-opinion that comprises both an expert opinion and a prudent investor opinion. As a result, any system disclosed or suggested by the combination of the Boe et al. and Ho et al. references fails to provide answers to customer questions that are tailored and polycentric, as recited by Applicants' claims 1 - 34. Even less does such a system provide the plurality of answer-opinions as claimed herein.

The plurality of answer-opinions comprising both expert and prudent-investor views affords a user of Applicants' system with a more encompassing and useful basis for financial decision making than any system which provides but a singular opinion. As Applicants have noted at page 2, lines 21 to 25, much of the financial advice currently available to the public represents particular viewpoints, and in some cases, viewpoints of those who stand to benefit (e.g., financially) from certain courses of action. Recent, widespread reports of improprieties by some in the financial community have made private investors wary of information sources that represent but a single viewpoint. By way of contrast, Applicants' system provides plural answer-opinions in response to

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user questions, thereby mitigating much skepticism about advice from a single source. Moreover, a user of the present system is freed from having to consult plural sources to obtain plural opinions. Instead, a single interaction more expeditiously provides such plural answers. Adduction of numerous, multifaceted views concerning a given situation provides a composite opinion with increased perspective that affords far greater value to the user than the singular point of view presented using any method disclosed or suggested by the cited references.

Furthermore, Ho et al. does not disclose or suggest the provision of a plurality of answer-opinions to a user question. While in some embodiments (e.g. claims 62 – 63) the Ho et al. system prompts the user with a plurality of responses, the user is intended to select one of the plural responses in order to clarify some aspect of a user's previous inputs. It is respectfully submitted that such plural responses are to be distinguished from the plural answer-opinions provided by Applicants' system, all of which are alternatives regarded by at least one expert or prudent-investor as being appropriate in a particular situation.

Thus, it is clear that even assuming *arguendo* that it is proper to combine the disclosures of both references, all of the features of Applicants' claimed invention would still not be shown. Hence, the combination of Boe et al and Ho et al. does not support the obviousness rejection under 35 USC §103 of claims 1-34. Consequently, this rejection should be withdrawn.

8. It is Improper to Combine the Disclosures of Boe et al. and Ho et al.

It is stated in the Final Rejection that

"The motivation to combine [the references] is to disclose a system that

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can (answer) a user based on his questions as enunciated by Ho (col. 2, lines 14-25) and which can be applied to financial planning”.

It is respectfully submitted that there is nothing in common with the disclosures of Boe et al. and Ho et al. to support the suggested combination, and there certainly is nothing in either reference which even remotely suggests such a combination.

The Boe et al. patent is directed to a system for profiling customers for targeted marketing. This is done to provide a business with specific information on a customer, so that products or services can be specifically targeted to the individual. This approach is an alternate to cold calling customers via telemarketing. The benefit to the customer is that the customer is provided with comparative data in a selective peer group.

On the other hand, Ho et al. is directed to a learning method and system based on questioning. Their system generates study materials that introduce a subject. After studying the materials, the student can begin asking questions, with the system generating an answer to each question. The system also compares the question with previously asked questions asked by the student to determine the student's understanding level.

The issue presented is whether there is any indication, from the references or otherwise, that suggests to one skilled in the art that the references should be combined. The answer is that there is nothing in the record to support such a combination, absent improperly using Applicants' own disclosure against them. Boe et al. deal with a system to profile customers for targeted marketing, whereas Ho et al. deal with a learning method. Why would anyone skilled in the art consider some modification of the Boe et al. system by using one or more features from Ho et al.? There simply is

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no reason to look to a patent on an esoteric learning method to modify or improve upon a system which is directed to targeted marketing – these fields are just too far apart. It is improper to merely cut and paste some disclosure in Ho et al. into the teaching of Boe et al. absent a valid need and a valid reason to do so.

In the Final Rejection, the alleged motivation to combine the references is as quoted above. With all due respect, this is not a motivation. Just because a system can answer a user's questions does not mean that it can be applied to financial planning. And, the financial planning mentioned in Boe et al. merely provides a product to target customers and gives the customers feedback as to where they stand within a peer group.

It is respectfully submitted that one having ordinary skill in the art, which is the legal standard for determining obviousness, (1) would not be motivated in any respect to modify the system of Boe et al. and (2) would certainly not look to a teaching in the learning field (Ho et al.) to improve upon a targeted marketing system. It is clear that the teachings of the applied references are in such diverse fields that one having ordinary skill in the art would simply not combine them.

Therefore, it is also respectfully submitted that the references cannot be properly combined as suggested. Furthermore, even if the references were somehow properly combined, Applicants' invention would still not be taught for the reasons mentioned in the previous section.

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9. The Rejections of All of the Claims are in Error

The following is a discussion of each of the claims with regard to the above comments made with respect to all of the claims. It is respectfully submitted that all of the claims are patentable.

Claim 1 – the references do not suggest, *inter alia*, a plurality of answer-options to a selected issue-question, which comprise at least one expert opinion and one prudent-investor opinion, with the response being polycentric and tailored to the issue-question.

Claims 2 and 3 – the references do not suggest, *inter alia*, gathering data relating to personal finance and investment from a plurality of sources including survey data and focus group data, for step (a) and step (b), respectively, of claim 1.

Claim 4 – the references do not suggest presenting each issue-question to an expert and storing the answer, for step (c) of claim 1.

Claim 5 – the references do not suggest presenting each issue-question to a prudent-investor and storing the answer, for step (d) of claim 1.

Claim 6 – submitted to be patentable for the same reasons as claim 1.

Claims 7 and 8 – submitted to be patentable for the same reasons as claims 2 and 3, respectively.

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Claim 9 – submitted to be patentable for the same reasons as claim 4.

Claim 10 – submitted to be patentable for the same reasons as claim 5.

Claim 11 – additionally submitted to be patentable as neither reference discloses nor suggests using a television medium to broadcast the plurality of answer-options.

Claims 12 and 13 – additionally submitted to be patentable as neither reference discloses nor suggests recording a plurality of answer-options on videotape or DVD, respectively.

Claim 14 – submitted to be patentable for the same reasons as claim 1, as well as the fact that neither reference discloses nor suggests modifying primary information by the plurality of answer-options of both expert and prudent-investor opinion to produce the polycentric information product.

Claims 15 and 16 – submitted to be patentable for the same reasons as claims 2 and 3, respectively.

Claim 17 – submitted to be patentable for the same reasons as claim 4.

Claim 18 – submitted to be patentable for the same reasons as claim 5.

Claim 19 – submitted to be patentable for the same reasons as claim 1.

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Claim 20 – additionally submitted to be patentable since neither reference discloses nor teaches entering information specific to a user's investment preferences and geographic location.

Claim 21 – additionally submitted to be patentable since neither reference discloses nor teaches a copy-editor to evaluate and eliminate answer-options with the same content, so that only unique ones are displayed to the user.

Claim 22 – additionally submitted to be patentable since neither reference discloses nor teaches assigning a content code and displaying only one of the answer-options with the same content code to the user.

Claim 23 – submitted to be patentable for the same reasons as claim 1, and since neither reference discloses nor teaches notifying the user via an e-mail message and providing a hyperlink from which the both the issue-question and answer-options can be accessed.

Claim 24 – additionally submitted to be patentable since neither reference discloses nor teaches assigning a preference code to each answer-option.

Claim 25 – additionally submitted to be patentable since neither reference discloses nor teaches assigning a preference code to the user.

Claim 26 – additionally submitted to be patentable since neither reference discloses nor teaches filtering the answer-options to include only those with a user's preference code.

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Claim 27 – additionally submitted to be patentable since neither reference discloses nor teaches using Bayesian inference and information theory in attempting to match the stored issue-question with the submitted question.

Claim 28 – additionally submitted to be patentable since neither reference discloses nor teaches, *inter alia*, deriving a probability that a reason for a cluster is the presence of a particular context, the same context that exists within the issue-question.

Claim 29 – additionally submitted to be patentable for the same reasons as claim 23.

Claim 30 – additionally submitted to be patentable since neither reference discloses nor teaches, *inter alia*, providing a plurality of expert opinions that are substantially diverse and collectively produce a polycentric information product tailored to the issue-question.

Claim 31 – additionally submitted to be patentable since neither reference discloses nor teaches assigning a content-code to each answer-option and selecting only one of the answer-options with the same content code to be displayed to the user.

Claim 32 – submitted to be patentable for the same reasons as claims 27 and 30.

Claim 33 – additionally submitted to patentable for the same reasons as claim 28.

Claim 34 – additionally submitted to be patentable for the same reasons as claim 23.

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As can be seen, each of claims 1-34 defines patentable subject matter over the proposed combination of references and should be allowed.

SUMMARY

It is respectfully submitted that the foregoing has demonstrated that claims 1-34 of the present invention recite subject matter which is clearly patentable over the applied references and fully complies with 35 USC §112. Applicants have provided a unique solution to the problem of obtaining financial advice, which should be recognized as patentable.

Accordingly, Applicants respectfully request reconsideration and withdrawal of all of the rejections of claims 1-34 and allowance of the application. Early notice to that effect is respectfully solicited. If the Examiner believes that a discussion with Applicants' attorney would in any way advance the prosecution of this application, he is respectfully requested to telephone the undersigned.

Respectfully submitted,

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*Signature***Ernest D. Buff***Attorney of Record*September 8, 2003*(Date)*